

C1  
said first insulated wall structure having a first opening defined therein for providing access to said first enclosed chamber, a portion of said first insulated wall structure being moveable to close said first opening;  
said first chamber being maintainable at a different environmental condition from said second chamber.

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C2  
28. (Twice Amended) A soft sided, collapsible, insulated container comprising:

a first collapsible insulated container portion, a second collapsible insulated container portion and an insulated common wall shared between said first and second container portions;  
said first container portion having a first insulated wall structure defining a first enclosed chamber therewithin;  
said first insulated wall structure having a first opening defined therein for providing access to said first enclosed chamber, a portion of said first insulated wall structure being moveable to close said first opening;  
said second container portion having a second insulated wall structure defining a second enclosed chamber therewithin;  
said insulated common wall segregating said first and second enclosed chambers from each other;  
said first chamber being maintainable at a different environmental condition from the environmental condition of said second chamber; and  
said first container portion being moveable between an expanded position and a collapsed position relative to said common wall, said first container portion being securable in said collapsed position.

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### REMARKS

#### 1) Summary of the Prosecution to Date

Claims 1, 2, 4 and 19 to 44 are currently pending in the subject application. Claims 3 and 5 - 18 have been cancelled.

In the second Office Action (made final) of April 10, 2002, claims 1, 2, 4 and 19 to 44 were rejected under the judicially created doctrine of obviousness-type double patenting over

claims 1-29 of U.S. Patent No. 6,243,677. In addition, claims 1, 2, 4, 19 to 22 and 28 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,877,128 to Strickland.

By a response to Final Office Action of June 10, 2002, the applicant responded to these outstanding rejections. By an advisory action mailed June 21, 2002 the Examiner acknowledged the filing of the terminal disclaimer. Nonetheless, notwithstanding the applicant's argument, the Examiner maintained the rejections based on US Patent 4,877,128 of Strickland. The Examiner indicated that, in light of the filing of the terminal disclaimer, claims 23 - 27 and 29 - 44 have been objected to, but would have been allowable if re-written in independent form.

The applicant then appealed the rejections of claims 1, 2, 4 and 19 - 44, and, to that end, filed an Applicant's Brief on Appeal on December 10, 2002. The Examiner's Response was mailed on January 27, 2003.

Claims 1, 2, 4 and 19 - 44 are pending in this application and do not stand allowed.

## 2) **Functional Limitations**

In the Office Action dated April 10, 2002, the Examiner rejected claims 1, 2, 4, 19 - 22 and 28 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,877,128 to Strickland, stating, *inter alia*:

"Regarding the terms "maintainable" and "securable", it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In Re Hutchinson*, 69 USPQ 138."

In reply, the applicant traversed this argument, and submitted that a functional recitation is a patentable limitation and such must be evaluated and considered just like any other limitation in a claim.

### A. **A Functional Recitation is a Patentable Limitation**

The MPEP currently reads, in part, as follows:

### 2173.05(g) Functional Limitations

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like an other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. (Emphasis added).

...  
It was held that the limitation used to define a radical on a chemical compound as “incapable of forming a dye with said oxidising developing agent” although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

In a claim that was directed to a kit of component parts capable of being assembled, the court held that limitations such as “members adapted to be positioned” and “portions ... being resiliently dilatable whereby said housing may be slidably positioned” serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia* 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

Clearly, *In re Barr* removes any doubt about whether “capable of”, or “incapable of” are acceptable.

In the present instance, the term “maintainable” as it is used in claim 1 expresses a feature, namely a physical property of the claimed insulated container. To paraphrase *Venezia*, it serves to define structural attributes (i.e., the ability to maintain different environmental conditions) of interrelated component parts (the first and second chambers) of the claimed assembly (the insulated container). Accordingly, the Appellant respectfully submits that claim 1 is patentable over Strickland in view of the limitation that the first chamber is maintainable at a different environmental condition from the second chamber.

In like fashion, the term “securable” as it is used in claim 28 also expresses a feature of the claimed insulated container. In this instance, the term serves to define the structural attributes (securability in the collapsed position) of interrelated component parts (the first

container portion) of the claimed assembly (the insulated container). Moreover, the Appellant further submits that claim 28 is patentable over Strickland in view of the limitation that the first container portion be securable in the collapsed position and further, in light of the limitation that the first chamber be maintainable at different environmental condition from the environmental condition of the second chamber.

B) *In re Hutchinson – Post Script*

The present rejections under 35 USC 102 again additionally require that at least one element of independent claim 1, and at least two elements of independent claim 28, be ignored, namely the claimed physical property that the insulated chambers be maintainable at different environmental conditions, and the claimed physical property (in claim 28) that the container portions be securable in a collapsed position.

Given that the Strickland reference neither shows nor describes either feature, the Examiner formerly cited *In re Hutchinson* to argue that those features were not patentable limitations, and thus need not be shown in the cited art. In response the applicant demonstrated that (a) *In re Hutchinson* is no longer good law (if it ever was); (b) the statute was amended in 1952 for the purpose, *inter alia*, of permitting functional claim language; and (c) the procedure set out in the MPEP had not been followed by the Examiner.

In passing, the applicant respectfully submits that, in basing a “final” rejection on an incorrect understanding of the law (namely *In re Hutchinson*), the office action of April 10, 2002 was improperly made final. It is, again, a fundamental issue of fairness that while the applicant may fairly be required to overcome rejections that have a basis in the law, it is entirely unreasonable to expect the applicant to have to address rejections that do not have a basis in law, such as those purportedly founded on *In re Hutchinson*. On that ground, alone, the applicant respectfully submits that it was, and is, entitled to seek a properly prepared office action, whether “final” or otherwise, in place of the office action of April 10, 2002.

C) *Ex parte Masham*

Notwithstanding the foregoing in the “Response” of January 27, 2003, the Examiner has taken substantially the same position (i.e., that structural elements must be added) without naming *In re Hutchinson*. That is, the Response states, “... appellant’s “different environmental

conditions” ... are not positive structural limitations of the claimed invention, but merely a function ...” and “...appellant’s term “securable” is not a positive structural limitation of the claimed invention, but merely a function ...” As support, the Examiner now cites *Ex parte Masham*.

In substance the Examiner is still trying to compel the applicant to add unnecessary structural limitations to the claims. This seems to miss the point. The Examiner does not appear to have accepted the fact that functional claim language is permitted by law in the United States, and has been for the last 50 years (if not, indeed, longer). The applicant respectfully submits that in light of the 1952 amendments, whether the two features to which the Examiner objects are, or are not, “positive structural limitations” is irrelevant.

D) *Ex parte Masham – Grounds Not Previously Stated*

As a preliminary comment, the applicant notes that *Ex parte Masham* has not previously been cited, and that, prior to appeal, the applicant has had no opportunity to respond to this newly cited caselaw. That is, if the citation of *Ex parte Masham* is necessary to support the rejection, then for the rejection properly to have been made this case should have been cited in the Office Action of April 10, 2002.

The applicant notes that the principle upon which *Masham* is cited is quite different from the principle upon which *Hutchinson* was cited. That is, the ground of the refusal to consider the two features has changed to one that has not previously been articulated in this matter. As such it was clearly a “new ground”, contrary to 37 CFR 1.193 (2).

Again, the applicant respectfully submits that it was neither fair nor reasonable to cite entirely new grounds in caselaw in the “Response to Brief on Appeal”.

E) *Current Position is Inconsistent With Previous Position*

In the Office Action of April 10, 2002, the Examiner characterised the features of “being maintainable at different environmental conditions” (claims 1 and 28) and “being securable” (claim 28) as functional limitations, so that *In re Hutchinson* could be applied. The office action of April 10, 2002 read, in part, as follows:

“Regarding the terms “maintainable” and “securable” it has been held that the recitation that an element is “capable of performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense *In re Hutchinson*, 69 USPQ 138.”

That argument having failed, in order to permit application of *Ex parte Masham* the Examiner has now re-characterised “being maintainable at different environmental conditions” and “being securable” as (1) “...but merely a function of [the relevant element] and (2) “... a recitation with respect to the manner in which a claimed apparatus is intended to be employed ...”.

With all due respect, the applicant submits that, in view of the former interpretation, from which the Examiner apparently now resiles, this subsequent characterisation is, or perhaps characterisations are (a) inconsistent; and consequently (b) somewhat lacking in credibility.

The applicant respectfully submits that the former characterisation, and the former attempt to apply *In re Hutchinson*, was an admission that the features of being “maintainable” and “securable” are functional properties of the claimed invention. The applicant respectfully submits that the Examiner is now estopped from reversing his ground on the issue.

#### *Ex parte Masham* – Does Not Support Rejection

In any case, the applicant respectfully submits the *Ex Parte Masham* does not support the Examiner’s argument. If anything, *Ex Parte Masham* supports the applicant’s argument.

As a preliminary matter, notwithstanding the explanation provided in the Response to the Applicant’s Brief on Appeal, the applicant notes that the Examiner has still not provided an ordered, element-by-element comparison of the claims with the Strickland reference. In that light, the applicant takes this opportunity to quote the full text of claim 1, as amended at the time *Masham* was applied:

Claim 1 – (As formerly pending)

1. (Twice Amended) A soft sided, collapsible, insulated container comprising:  
a first collapsible insulated container portion defining a first insulated chamber  
therewithin;  
a second collapsible insulated container portion defining a second insulated chamber  
therewithin;  
said first and second insulated container portions having respective first and second  
insulated wall structures, said insulated wall structures including respective  
insulated sidewall panels;  
said insulated chambers being located side-by-side, and being segregated by a common  
wall;  
said first insulated wall structure having a first opening defined therein for providing  
access to said first enclosed chamber, a portion of said first insulated wall  
structure being moveable to close said first opening;  
said first chamber being maintainable at a different environmental condition from said  
second chamber.

Claim in *Ex parte Masham*

*Ex parte Masham* involved a claim for a mixing apparatus. A copy of the decision reported at 2 USPQ 2d is enclosed for the convenience of the Board. In that case claim 1 read as follows:

1. An apparatus for mixing flowing developer material, including:  
means defining a chamber, for receiving the flowing developer therein; and  
means for mixing the following [flowing ?] developer material, said mixing means being  
stationary and completely submerged in the developer material.

Reasons in *Masham*

In the reasons in *Ex parte Masham*, Examiner-in-Chief Steiner wrote

(a) that the preamble recitation “for mixing flowing developer material...” and the additional recitation “completely submerged in the developer material” relate to the identity of

the material worked upon by the claimed apparatus and the intended manner of employing the claimed apparatus.

(b) that the cited item of prior art had all of the structural limitations of the claimed apparatus (as opposed to the material worked on by the claimed apparatus), and that "... a recitation with respect to the material intended to be worked upon by a claimed apparatus does not impose any structural limitations upon the claimed apparatus which differentiates it from a prior art apparatus satisfying the *structural* limitations of that claimed. Similarly, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the *structural* limitations of that claimed." (Emphasis in original, references omitted).

(c) "In this respect, the examiner has factually determined that Williams' mixing device 40 is capable of being totally submerged in the developer material, since gate 46 is *capable* of retaining a supply of developer above the top surface of mixing device 40. Appellant has not challenged the examiner's factual determination, which determination appears to be based on sound technical reasoning." (Emphasis in original).

And, further,

(d) "In *In re Pearson*, it was held that a recitation of intended use in a claim directed to a composition does not impose any limitations which differentiates the claimed composition from those which are known in the art. By analogy, the apparatus disclosed by Williams does not undergo a metamorphosis to a new apparatus merely by affixing instructions thereto indicating that a sufficient amount of developer material may be poured into the apparatus to completely submerge the stationary mixing means."

Considering (a) to (d), and considering the features of claim 1 to which the Examiner currently objects:

Re: (a)

The applicant has provided, and has positively recited, a physical property of the claimed invention, namely: "said first chamber being maintainable at a different environmental condition from said second chamber. The functional language is not used in the preamble. Nor is the functional language related to the identity of the material worked upon by the claimed apparatus.



Nor does the functional language describe the intended manner of employing the claimed apparatus. It expresses a physical characteristic of the apparatus. Therefore, with regard to observation (a) of *Masham*, claim 1 is clearly and indisputably acceptable as presently drafted.

Re: (b)

(i) In *Masham*, the claimed apparatus did not have any functional limitations. With regard to the apparatus actually claimed, it had only structural limitations. It is not surprising, therefore, that the prior art Williams reference was considered only on the basis of structural elements: there were no properly recited functional elements to compare.

(ii) In present claim 1, in contrast to *Masham*, the claim does not include any recitation with respect to any material to be “worked upon” by the apparatus. On the contrary, the claim only recites elements of the claimed apparatus.

(iii) In present claim 1, in contrast to *Masham*, the claim does not include any recitation of how the claimed apparatus is intended to be used: maintainable is an adjective, it is neither a verb in the present indicative or in the subjunctive, nor is it a gerundial form of a verb. On the contrary, all of the elements of claim 1 pertain to the physical attributes of the claimed invention.

Thus, the applicant submits that present claim 1 is fully consistent with (b).

Re: (c)

The test for anticipation requires that there be a clear and unambiguous showing that the claimed elements are found in exactly the same situation, and united in the same way to perform the same function in a single unit of prior art. Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture.

In contrast to *Masham*, the Examiner has not shown that the Strickland reference has the physical capability recited in the present claim. On the contrary, as previously stated, the only reasonable inference from Strickland’s structure is that the chambers are not intended to be capable of being maintained at different environmental conditions. To summarise, there is an insulated container that Strickland refers to as a “bottle caddy”. It has an outer insulated wall (item 16) that defines a large insulated zone. A smaller bottle holding device, made up of items 11 and 12, is placed inside item 16. The outer wall (item 16) is separated from the inner wall (item 11) such that a peripheral gap, item 15, extends around items 11 and 12. The gap is symmetrical, and is intended to accommodate cooling packs (item 23) on all four sides of the

baby bottles 14. There is no suggestion whatsoever that either item 11 or item 12 is insulated to impede heat transfer from cooling packs 23 to bottles 14, and, indeed, an insulating function would appear contrary to the general idea of keeping the baby bottles cool by placing them next to the cooling packs. Similarly, there is no suggestion whatsoever that any of the baby bottles is intended to be kept cooler (or warmer) than any other. The entire assembly is symmetric, which strongly suggests that the assembly is intended to keep the baby bottles all at the same (presumably cool) state: "The gap 15 accommodates a series of refrigerant containers 23 therewithin and effects continuous cooling of the bottles 14 positioned within the compartments 11a". (Strickland, col. 4, lines 5 – 8).

Thus, in contrast to *Masham*, the factual finding pertaining to maintainability of different environmental conditions in the first and second chambers is clearly not supported by anything in the reference, but, if anything, appears to be contradicted by it. The applicant respectfully submits that a rejection under 35 USC 102, cannot stand where there is clear omission of a claimed element.

Second, in contrast to *Masham*, the applicant has vigorously contested the position taken by the Examiner.

Third, in contrast to *Masham*, for the reasons stated above (namely that the reference suggests that the chambers are to be kept at much the same temperature) the Examiner's position is clearly not based on "sound technical reasoning": it appears to require that the reference be either ignored or contradicted. As such, the rejection does not conform to *Masham*.

Thus, for the foregoing reasons, the applicant submits that the use of "are maintainable at different environmental conditions", conforms to part (c) of *Masham*.

Re: (d)

In contrast to *In re Pearson* (cited in *Masham*) neither the present claim 1, nor any other claim presently pending in the application, (a) is a composition-of-matter claim ; or (b) recites an intended use.

Conclusion re: *Masham*

In summary then, even without amendment, the claims pending in this case (a) were consistent with the holding in *Masham*; and (b) the position taken by the Examiner is not supported by *Masham*. In that light, the applicant respectfully submits that, if anything, *Masham* supports the applicant's position, not the current rejection.

3) **Strickland does not anticipate Claims 1, 2, 4, 19-22 and 28**

A. Statement of the Law Regarding Anticipation under 35 U.S.C. 102(b)

Anticipation can only be established by a single prior art reference: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *Structural Rubber Products Co., v. Park Rubber Co.*, 749 F.2d 7070; 223 U.S.P.Q. 1264 (C.A.F.C. 1984). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The test for anticipation requires that all of the claimed elements must be found in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Kohle, m.b.H. v. Dart Industries, Inc.*, 762 F.2d 724, 726, 220 U.S.P.Q. 841 at 842 (C.A.F.C. 1984). Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture. *Datascope Corp. v. SMEC Inc.*, 594 F. Supp. 1036; 224 U.S.P.Q. 694, 698 (D.N.J. 1984).

B) Convoluting Interpretation of Strickland

The applicant traverses the interpretation placed on the Strickland reference by the Examiner. The Examiner has taken the view that by creating an arbitrary combination of a portion of item 16 with a portion of item 11, and a portion of item 12, he can concoct the claimed term "a first collapsible insulated container portion defining a first insulated chamber therewithin". Similarly, by combining another portion of item 16 with another portion of item 11 and another portion of item 12, he can arrive at "a second collapsible insulated container portion defining a second insulated chamber therewithin", and thus he can satisfy two of the

recited limitations of the present claims.

The applicant respectfully disagrees. Patent claims are to be interpreted through the eyes of the reasonable man of ordinary skill in the art. Although stated in the context of litigation, the applicant respectfully submits that the following principle of claim construction applies equally to the present matter:

“If an argument offered in support of a particular claim construction is so convoluted and artificial that it would not be apparent to a skilled artisan reading the patent and the prosecution history, the argument is simply unhelpful to the performance of [the task of claim construction].” (*Dayco Products, Inc. v. Total Containment Inc.*, 59 USPQ 2d 1489 at 1495 (CAFC, 2001)).

The applicant respectfully submits that there is no support whatsoever in the Strickland document, whether in the description, the drawings, or the claims for making the convoluted and artificial interpretation now made by the Examiner arbitrarily to combine portions of the disparate features shown in Strickland. Strickland shows a single insulating element – item 16 – that fully surrounds, items 11 and 12, leaving a large peripheral gap, 15 to accommodate cooling media. In no way is there any support in Strickland’s disclosure, drawings, or claims to support a structural association of any particular “portion” of item 16 with any particular “portion” of item 11 (and item 12), let alone the arbitrary half-sectioning of the Examiner’s explanation.

Item 16 can not in any reasonable way be said to “define” either the “first chamber” or the “second chamber”. As shown by Strickland, items 11 and 12 may define the “first chamber” and the “second chamber”, but they are not insulated, nor do they have “respective” insulated sidewall panels. Nor is there any differentiation between the insulative benefit obtained by any one of the bottle holder sockets defined by items 11 and 12 obtained from any particular portion of item 16. The insulating nature of item 16 defines a single, relatively large, enclosed insulated space, without any portion of item 16 being identifiably either structurally or functionally associated with any particular part of item 11, item 12, (or, for that matter, items 23) in the manner now suggested by the Examiner. The arbitrariness, and the functional weakness of the rejection can be demonstrated by removing either of the “insulated wall portions” of item 16 suggested by the Examiner as belonging to either the first or second insulated container portions. The result is that then neither the “first chamber” nor the second chamber can thereafter reasonably be said to be “insulated”. It is difficult, therefore, to understand how the requirement for “respective insulated sidewall panels” can be met by the Strickland reference.

The extent to which this is true may also be demonstrated by analogy.

First analogy.

An R-2000 house has heavily insulated walls. Inside the house two glasses sit on a dining room table. By the Examiner's logic, the chamber defined inside each glass is an "insulated" chamber, because the house has insulated walls, and so, therefore, everything inside the walls can be characterized as "insulated", even though the glasses are not themselves "insulated" in any way. To reinforce this position, following the logic of the Examiner's interpretation of Strickland, part of the walls (perhaps the North and East walls) of the house, and one glass, are arbitrarily defined as being a first insulated wall portion, and another portion of the walls (perhaps the South and West walls) and the other glass are arbitrarily defined as being a second insulated wall portion.

Second analogy.

A freezer contains an ice-cube tray. The freezer has insulated walls. According to the Examiner's present logic, each socket of the ice cube tray is a separate "insulated chamber" since a portion of the insulated freezer wall (say, the front, or maybe the left hand side, the choice being arbitrary) can be associated with one ice-cube socket, and therefore be defined as a first insulated wall structure, and another portion of the insulated freezer wall (say the back, or the right hand side, the choice being arbitrary) can be associated with another ice cube socket, and therefore be defined as a second insulated wall structure.

The applicant respectfully submits that the two foregoing analogies demonstrate the convoluted and artificial nature of the Examiner's interpretation of Strickland. That is, the first and second container portions, as defined by the Examiner, no more have "respectively" insulated sidewall panels than either the ice-cube tray sockets in the second analogy, or the glasses in the first analogy. To suggest, as the Examiner has done, that in Strickland the "first and second insulated wall structures have respective insulated sidewall panels", is a fiction. There is no support anywhere in Strickland for the serendipitous selection and combination of the panels made by the Examiner. On the contrary, it is an arbitrary apportionment that has been conjured out of thin air. In this regard, anticipation cannot be based on conjecture. (*Datascope Corp. v. SMEC Inc.*, supra.)

In Summary, with regard to claim 1, the applicant respectfully submits that

- (a) The feature of the first and second chambers of the claimed container being maintainable at different environmental conditions is fully acceptable claim language under US law;
- (b) the feature of the first and second chambers of the container being maintainable at different environmental conditions is a positive physical property of the claimed invention;
- (c) the feature of the first and second chambers of the container being maintainable at different environmental conditions is clearly not taught by Strickland; and
- (d) as such, claim 1 is not anticipated under 35 USC 102 by Strickland.

Furthermore,

- (e) the reading of Strickland provided by the Examiner relies on a “convoluted and artificial” construction, as rejected in *Dayco Products Inc.*; and
- (f) Strickland does not have the insulated container portions of claim 1 and their respective insulated wall portions as claimed.

Re: “Securable in the collapsed condition”

The same commentary as made above can, in large measure, also be made in the context of claim 28 and “securable in the collapsed condition”. That is, (a) the recited feature is functional; (b) it neither occurs in the preamble nor does it relate to “the identity of the material worked upon by the apparatus”. Further, the Examiner has not shown that Strickland demonstrates that the collapsible container is securable in the collapsed position. Further still, the applicant has not acceded to the Examiner’s rejection, but has traversed it vigorously. Finally, claim 28 is not a composition claim, and the feature to which the Examiner objects is not “an intended use”. “Securable” is an adjective defining a physical property of the antecedent noun. It is not a verb form for a method or process step. It is not a noun for a use.

Furthermore, Strickland neither teaches nor describes that internal compartment 11a is securable in a collapsed position. Nor has the applicant identified any reference in Strickland that shows this feature. Accordingly, Strickland cannot serve as an anticipatory reference as it does not teach each and every feature of the applicant’s claim 28. The applicant respectfully submits that claim 28 is allowable over Strickland.

#### Amendments to Claims 1 and 28

Out of an abundance of caution, the applicant has amended claim 1 to indicated the common wall between the first and second chambers is an insulated wall. This is a feature that, even on the interpretation of Strickland presented by the Examiner, the Strickland reference clearly does not have. Nonetheless, in view of the foregoing arguments, the applicant respectfully submits that these amendments are not required for claims 1 and 28, and any claims dependent therefrom, to be patentable over Strickland.

#### 4) Further Commentary

##### Claims 2 and 4: Bottles as Liners

In the context of claims 2 and 4, it is alleged that bottles 14 constitute a liner, or liners, of the various chambers. The applicant respectfully traverses this interpretation.

The bottles are not part of Strickland's assembly at all, as indicated by the dashed lines in which they are illustrated (see Strickland Figures 1, 2 and 3). The Examiner is trying, again, to stretch the definition of an item beyond that which could reasonably be attributed to it by a person of ordinary skill in the art. The bottles shown by Strickland are not "a liner", or "liners" of the container. They are the intended contents of the container.

The applicant submits that while the Examiner is entitled to take a broad view of the reference, that view cannot be so broad as to make a nonsense of it. Strickland explicitly refers to the baby bottles as such. That is the plain and ordinary meaning that one would put on the term, and it is in accord with the Strickland's illustrations. The applicant submits that the characterisation of any of the baby bottles as "liners" of the container is contrived and artificial, and is not an interpretation that is reasonably or fairly borne by the feature shown in the reference.

5) **Conclusion**

In summary, the Examiner's rejections of claim 1, 2, 4, 19 - 22 and 28 rest on the view that a functional recitation is not a patentable limitation. The courts have recognized that functional limitations are proper and ought to be considered like any other limitation in a claim. Accordingly, the Appellant respectfully submits that the Examiner erred in refusing to consider the use of the terms "maintainable" and "securable" as positive limitations in the claims.

Further, the applicant respectfully submits that the Examiner erred in relying on an interpretation of the cited Strickland reference that is convoluted and artificial, contrary to the principles of claim construction given in *Dayco Products*.

In addition, the Examiner has erred in finding that the claims 1, 2, 4 19 - 22 and 28 were anticipated by Strickland, when this latter reference is clearly missing elements of the claimed invention.

When the use of these words in the claims are taken into account, the claim construction employed by the Examiner to interpret the cited Strickland reference cannot be supported, and the rejections under 35 U.S.C. §102(b) on the basis of Strickland cannot be properly made. The Appellant again respectfully submits that the Strickland reference should not have been cited against any of the claims presently pending in this case.


This final rejection being in error, therefore, the applicant requests early and favourable disposition of this matter.



In the event that any fees are due with respect to this paper, please charge our Deposit Account No. 01-2300, referencing our docket number of 100570-00018.

Respectfully submitted,

ARENT FOX KINTNER PLOTKIN & KAHN, PLLC

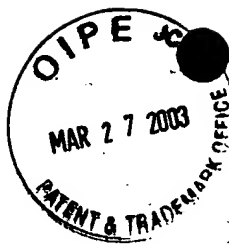


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CMM:mmg

Enclosure:    Marked-up Claims 1 and 28



Marked-Up Copy of Claims 1 and 28  
U.S.S.N. 09/859,451

1. (Thrice Amended) A soft sided, collapsible, insulated container comprising:
  - a first collapsible insulated container portion defining a first insulated chamber therewithin;
  - a second collapsible insulated container portion defining a second insulated chamber therewithin;
  - said first and second insulated container portions having respective first and second insulated wall structures, said insulated wall structures including respective insulated sidewall panels;
  - said insulated chambers being located side-by-side, and being segregated by [a] an insulated common wall;
  - said first insulated wall structure having a first opening defined therein for providing access to said first enclosed chamber, a portion of said first insulated wall structure being moveable to close said first opening;
  - said first chamber being maintainable at a different environmental condition from said second chamber.
  
28. (Twice Amended) A soft sided, collapsible, insulated container comprising:
  - a first collapsible insulated container portion, a second collapsible insulated container portion and [a] an insulated common wall shared between said first and second container portions;
  - said first container portion having a first insulated wall structure defining a first enclosed chamber therewithin;
  - said first insulated wall structure having a first opening defined therein for providing access to said first enclosed chamber, a portion of said first insulated wall structure being moveable to close said first opening;
  - said second container portion having a second insulated wall structure defining a second enclosed chamber therewithin;
  - said insulated common wall segregating said first and second enclosed chambers from each other;
  - said first chamber being maintainable at a different environmental condition from the environmental condition of said second chamber; and

said first container portion being moveable between an expanded position and a collapsed position relative to said common wall, said first container portion being securable in said collapsed position.